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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,474	11/21/2001	Michael Safdeye	0851/111 18-US1	4563

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EXAMINER
LEE, EDMUND H

ART UNIT	PAPER NUMBER
1732	

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/991,474	SAFDEYE ET AL.	
	Examiner	Art Unit	
	EDMUND H. LEE	1732	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 May 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 22 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "cutting the sheet of fabric material...inserting step" *(cl 22, lns 2-3) is indefinite because it is unclear as to what is inserted into the injection mold. If it is the cut sheet of fabric material then it should be clearly and positively recited as such.

The phrase "the other mold" (cl 29, ln 3) lacks antecedent basis in the claim.

Clarification and/or correction is required.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 21-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2-283303A in view of CN 2405451Y. In regard to claim 21, JP 2-283303A teaches the basic claimed process including a method of manufacturing a sole (abstract; figs 1-3); providing a sheet of two-layer material (abstract; figs 1-3); and attaching the sheet of two-layer material to a shoe upper (abstract; figs 1-3). JP 2-283303A, however, does not teach injecting a sheet of fabric into an injection mold; injecting a curable, flowable, thermoplastic material into the mold

into contact with the sheet of fabric material for bonding therewith upon curing to form an integrated fabric-thermoplastic part; and removing the integrated fabric-thermoplastic part from the mold. CN 2405451Y teaches a method of making a fabric shoe sole (abstract; fig 1); inserting a sheet of fabric into an injection mold (abstract); injecting a curable, flowable, thermoplastic material into the mold into contact with the sheet of fabric material for bonding therewith upon curing to form an integrated fabric-thermoplastic part (abstract); and removing the integrated fabric-thermoplastic part from the mold (abstract). JP 2-283303A and CN 2405451Y are combinable because they are analogous with respect to molding shoes. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the fabric-thermoplastic part of CN 2405451Y as the insert of JP 2-283303A in order to form a shoe with increased anti-slip ability. In regard to claims 22-32, JP 2-283303A attaching the upper to the insert by not molding (fig 2); attaching the upper to a region of the insert that is not covered by the lower layer (fig 2)--as a note, this teaching meets the limitations of claims 26 and 27; inserting the two-layer material into another mold, injecting a curable, flowable thermoplastic material into the other mold into contact with the two-layer material for bonding therewith upon curing to form an outsole and removing the outsole from the other mold (fig 2); forming an annular gap surrounding the two-layer material part in the outsole (abstract; figs 1-3); molding an outsole having an outer surface which contacts the ground over a ground-engaging area (abstract; figs 1-3). JP 2-283303A, however, does not teach cutting the sheet of fabric material; preheating the mold; heating

thermoplastic pellets; inserting another sheet of fabric material into the injection mold and injecting the thermoplastic material between the spaced sheets; injecting the same thermoplastic material into both molds; providing an outsole with an outer layer which is exposed at the outer surface over an area at least half of the ground engaging area. In regard to cutting the sheet of fabric material, it is well-known in the molding art to pre-cut a preform in order to increase aesthetic appeal of the finished product. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to cut the fabric material of JP 2-283303A (modified) in order to achieve the above result. In regard to preheating the mold, such is well-known in the molding art in order to reduce cycle time. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to preheat the mold of JP 2-283303A (modified) in order to reduce cycle time. In regard to heating thermoplastic pellets, such is well-known in the injection molding art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to heat thermoplastic pellets to form the flowable thermoplastic material of JP 2-283303A (modified) in order efficiently provide the thermoplastic material of JP 2-283303A. In regard to inserting another sheet of fabric material into the injection mold and injecting the thermoplastic material between the spaced sheets, the specific design of the fabric material is a mere obvious matter of choice dependent on the desired final product. Fabric-thermoplastic-fabric composites are well-known in the molding art and shoe art for it's comfort. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was

made to use a fabric-injected thermoplastic-fabric composite in the process of JP 2-283303A (modified) in order to increase comfort of the shoe. In regard to injecting the same thermoplastic material into both molds, such is a mere obvious matter of choice dependent on the desired final product and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, it is well-known in the molding art to use the same material in order to increase bonding strength. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the same thermoplastic material in order to increase the bonding strength between the materials. In regard to providing an outsole with an outer layer which is exposed at the outer surface over an area at least half of the ground engaging area, such is a mere obvious matter of choice dependent on the desired final product and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, such is a well-known design in the shoe art in order to increase aesthetic appeal. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the claimed design into the design of the outsole of JP 2-283303A in order to increase the aesthetic appeal of the shoe of JP 2-283303A.

4. Applicant's arguments with respect to claims 1-7 and new claims 21-32 have been considered but are moot in view of the new ground(s) of rejection.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**.

See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Otis (USPN 6430844) teaches a shoe having a fabric outsole, wherein the fabric is over more than half of the outer surface of the outsole and has a thermoplastic backing.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDMUND H. LEE whose telephone number is 571.272.1204. The examiner can normally be reached on MONDAY-THURSDAY FROM 9AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on 571.272.1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EDMUND H. LEE
Primary Examiner
Art Unit 1732

EHL

7/9/04